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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,145	05/30/2000	Michael Underwood	GOVD-001	1308

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Olson & Hierl LTD  
36th Floor  
20 North Wacker Drive  
Chicago, IL 60606

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/580,145

Applicant(s)

UNDERWOOD ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Original claims 1- 9 have been examined. The rejections are stated below.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. In claim 1 the omitted step is: "if the buyer profile code of the at least one buyer does not match the first asset profile code". It is not clear from the claim 1 as presently stated as to how the method would work if the condition "if the buyer profile code of the at least one buyer does not match the first asset profile code" is met. Similarly in claims 6 and 8 the omitted step is "if the buyer profile code of the at least one buyer does not match the second asset profile code". It is not clear from claims 6 and 8 as presently stated as to how the method would work if the condition "if the buyer profile code of the at least one buyer does not match the first asset profile code" is met. Other claims are rejected because they depend on the rejected claims. Correction/Clarification is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godin et al (US Patent 5,890,138).

With reference to claim 1 Godin discloses a method for conducting an auction to sell an asset subject to seller-defined restrictions over a computer network comprising a plurality of computers that are able to communicate, the method comprising the steps of: (a) receiving seller input comprising a first asset profile code for the asset, wherein the first asset profile code comprises at least one community restriction which must be met by a buyer before the buyer is authorized to purchase the asset (See Godin Column 3 lines 31-40 and Column 4 line 63 – Column 5 line 5); (b) retrieving information provided by at least one buyer, the information comprising a buyer profile code (See Godin Column 4 lines 41-52); (c) comparing the buyer profile code of the at least one buyer with the first asset profile code to determine whether the buyer profile code of the at least one buyer matches the first asset profile code (See Godin Column 5 lines 4-6); (d) if the buyer profile code of the at least one buyer matches the first asset profile code, displaying the asset to the at least one buyer (See Godin Column 5 lines 6-8) (e) offering the asset for sale to the at least one buyer (inherent in the disclosure); (f) accepting bids on the asset from the at least one buyer (See Godin Column 1 lines 18-20); (g) concluding the auction at least upon expiration of a seller-defined time period for completing the auction (See Godin Column 3 lines 31-38)); and (h) determining a highest bid from the bids accepted during the auction (See Godin Column 1 lines 18-20). The country in which the product is listed is one of the asset profile codes and the country of the buyer is one of the buyer profile codes, the country in whose products the buyer can bid is the community restriction which must be met by the buyer and the matching of the country where the product

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is sold with the country of the buyer constitutes matching of the asset profile code with the buyer profile code.

With reference to claim 2, Godin teaches a method of claim 1 wherein the first asset profile code further comprises at least one asset restriction, which must be met by a buyer before the buyer is authorized to purchase the asset (See Godin Column 4 line 63 – Column 5 line 4).

With reference to claim 3, Godin teaches a method of claim 1 wherein the auction is conducted on the Internet (See Godin Column 3 lines 14-21).

With reference to claims 4 and 5, Godin teaches a method of claim 1 as discussed above.

Godin does not explicitly teach the steps of assigning a seller-defined strike price to the asset and concluding the auction occurs if the seller-defined strike price is met.

Official notice is taken that the steps of assigning a seller-defined strike price to the asset and concluding the auction occurs if the seller-defined strike price is met are old and well known in the art. Seller-defined strike price ensures that the seller is guaranteed a minimum price for the product and concluding the auction occurs if the seller-defined strike price is met helps the auctioneer to move on to other auctions while guaranteeing that the auctioned product is sold.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps of assigning a seller-defined strike price to the asset and concluding the auction occurs if the seller-defined strike price is met to the invention of Godin. The combination of the disclosures taken as a whole suggests that it would help ensure that the

seller is guaranteed a minimum price for the product and it would help the auctioneer move on to other auctions while guaranteeing that the auctioned product is sold.

6. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godin et al (US Patent 5,890,138) in view of Silverman et al (US Patent 5,924,082).

With reference to claims 6 and 8, Godin teaches a method of claim 1 as discussed above including the steps of offering the asset for sale to the at least one buyer, accepting bids on the asset from the at least one buyer, if either the seller-defined time period for completing the auction has expired or the seller-defined strike price is met (See discussion of claim 5 above), concluding the auction and determining a highest bid from the bids accepted during the auction.

Godin does not explicitly teach the steps of comparing the highest bid with the strike price and if the highest bid is less than the strike price then there is no winner or if there is no bid before the completion of the auction, the asset is assigned a second asset profile code different from the first asset profile code, wherein the second asset profile code comprises at least one community restriction, retrieving and comparing a buyer profile code with the second asset profile code to determine whether there is a match and if the buyer profile code of the at least one buyer matches the second asset profile code, displaying the asset to the at least one buyer.

Official notice is taken that the steps of comparing the highest bid with the strike price and if the highest bid is less than the strike price concluding there is no winner is old and well known in the art. These steps ensure that the seller is guaranteed a minimum price for the product. Silverman teaches the step of assigning the asset a second asset profile code different

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from the first asset profile code, retrieving and comparing a buyer profile code with the second asset profile code to determine whether there is a match and if the buyer profile code of the at least one buyer matches the second asset profile code, displaying the asset to the at least one buyer (See Silverman Column 4 lines 4-27). The transaction and other parameters or attributes are interpreted to include the second asset profile, the terms of acceptability is interpreted to include at least one community restriction and the step of displaying the potential transaction includes the step of displaying the asset to be traded.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps of comparing the highest bid with the strike price and if the highest bid is less than the strike price concluding there is no winner and the teachings of Silverman to the invention of Godin. The combination of the disclosures taken as a whole suggests that both the seller and the potential buyer would benefit from the knowledge that their requirements are properly matched and they would thereby save valuable time and effort in not pursuing deals where there is no proper matching.

With reference to claims 7 and 9, Godin teaches a method of claims 6 and 8 respectively wherein the second asset profile code further comprises at least one asset restriction, which must be met by a buyer before the buyer is authorized to purchase the asset (See Godin Column 4 line 63 – Column 5 line 4 and discussion of claim 6 above).


### *Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to

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7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
June 27, 2003

 Richard Weisberger  
Primary Examiner